

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of
Shuuichi Yatabe

Docket No. P27269

Confirmation No. 6237

Serial No.: 10/600,834

Group Art Unit: 3683

Filed: June 23, 2003

Examiner: King, Bradley T.

For: VACUUM PRESSURE BOOSTER

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Window, Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria, VA 22314
Sir:

This request is being filed concurrently with a Notice of Appeal and is responsive to the Final Official Action of March 8, 2006.

Reconsideration and withdrawal of the 35 U.S.C. §§ 112 and 102 rejections is respectfully requested in view of the following remarks.

A prima facie case of indefiniteness has not been set forth and the Rejection Under 35 U.S.C. § 112, 2nd paragraph, Is Improper

A prima facie case of anticipation has not been set forth and the Rejection Under 35 U.S.C. § 102(b), Is Improper

Examiner's Assertion

In rejecting claim 19 as being indefinite, the Examiner asserts that "it is not clear which element has the 'forward facing open end'."

Applicant's Response

Applicant respectfully disagrees. As explained in the Amendment under 37 CFR 1.116 filed on June 8, 2006, the noted feature is not indefinite or unclear. Fig. 6 of the instant application clearly shows a front valve holder 35A that includes a connecting portion 35Ac which extends into a recess of the rear valve holder 35B. The recess is

the reduced diameter portion of the rear valve holder 35B. Fig. 6 clearly shows a gap between the reduced diameter portion of rear valve holder 35B and valve cylinder 10. Fig. 6 also clearly shows that portion 35Ac extends into this recess. Furthermore, since the valve holder 35A has been defined as a "front" valve holder and since the valve holder 35B has been defined as a "rear" valve holder, Applicant has clearly established forward and rearward directions. Furthermore, Fig. 6 clearly shows that the recess which receives portion 35Ac has a forward facing open end. Indeed, it is apparent from Fig. 6 that this forward open end of the recess allows the portion 35Ac to enter into the recess.

Examiner's Assertion

In rejecting claim 21 as being indefinite, the Examiner asserts that certain features of this claim are not clear.

Applicant's Response

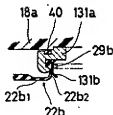
Applicant respectfully disagrees. As explained in the Amendment under 37 CFR 1.116 filed on June 8, 2006, claim 21 has been amended to recite that the pair of cylindrical holding portions comprise an annular recess having an open forward end and an annular protruding portion extending rearward into the annular recess from the open forward end, and the annular recess and the annular protruding portion comprise inner and outer circumferential surfaces which engage each other. Applicant submits that this claim has been amended consistent with the Examiner's comments. Each of the features recited in claim 21 are also fully supported in Fig. 6 and one having ordinary skill in the art would have no difficulty understanding the recited features. Furthermore, the Advisory Action of June 22, 2006 indicates that the Amendment was considered and would be entered for purposes of appeal.

Examiner's Assertion

In rejecting independent claim 1 as being anticipated by SUZUKI (US 5,190,125), the Examiner asserts that Figure 4 of SUZUKI shows that the attaching bead portion is tightly held between a pair of cylindrical holding portions formed in a pair of valve holders attached to the valve cylinder and engaging an inner circumferential face of the valve cylinder.

Applicant's Response

Applicant respectfully disagrees. Applicant submits that this feature is not disclosed in Figure 4 of SUZUKI, reproduced below.

Fig. 4

Claim 1 recites that the pair of valve holders, which the Examiner has identified as members 131a and 131b of SUZUKI, engage an inner circumferential face of the valve cylinder. This is not disclosed in Fig. 4 of SUZUKI. To the contrary, while it is true that Fig. 4 shows two members 131a and 131b, it is clear from Fig. 4 that only member 131a engages an inner circumferential face of the valve cylinder 18a. Member 131b simply does not engage an inner circumferential face of the valve cylinder 18a. As such, the Examiner simply cannot properly argue that Fig. 4 of SUZUKI discloses or suggests that the attaching bead portion is tightly held between a pair of cylindrical holding portions formed in a pair of valve holders attached to the valve cylinder and engaging an inner circumferential face of the valve cylinder.

Examiner's Assertion

The Examiner asserts on page 6 of the Final Office Action that "[t]he claim language does not require that each holder engage the inner face."

Applicant's Response

This assertion is not correct and is contrary to the express language of the claims. Claim 1 clearly states that the pair of valve holders is attached to the valve cylinder and engages an inner circumferential face of the valve cylinder. This is clearly shown in Fig. 6 which clearly illustrates that portions of both valve holders 35A and 35B engage with the inner circumferential face of the valve cylinder 10. Claim 1 simply cannot properly be read to recite that only one of the members 35A and 35B engages an inner circumferential face of the valve cylinder because claim 1 uses the term "pair".

As the Examiner knows, the term "pair" means two, and not one. Thus, the Examiner's argument that this language can be read to recite that only one of the valve holders engages with the valve cylinder is improper and contrary to the clear language of the claims.

Furthermore, as shown in Fig. 4 of SUZUKI, a circular groove is formed on the outer circumference of the first retainer 131a and an O-ring 40 is installed on the circular groove provided in the first retainer 131a. The first retainer 131a is secured in an air-tight manner to the cylindrical portion 18a of the piston body 18 through the O-ring 40 by pressing. Also, Fig. 4 shows a circular ring 131b, provided as a second retainer, secured to the inner circumference of the tubular portion of the first retainer 131a by pressing. However, the first retainer 131a does not include a protruding part, as recited in the claimed invention, nor does the circular ring 131b include a recessed portion, as recited in the claimed invention.

Applicant emphasizes that claim 1 clearly recites, for example, that the attaching bead portion is tightly held between a pair of cylindrical holding portions formed in a pair of valve holders attached to the valve cylinder and engaging an inner circumferential face of the valve cylinder. Fig. 4 of SUZUKI, in contrast, provides no engagement between member 131b the valve cylinder 18a, and instead provides engagement between member 131b and an inner circumferential surface of member 131a. Accordingly, the Examiner must acknowledge that Fig. 4 of SUZUKI fails to disclose, or even suggest, among other things, an arrangement wherein a pair of valve holders engages with an inner circumferential face of the valve cylinder.

Additionally, Applicant submits that the configuration of SUZUKI is, by far, more difficult to manufacture and assemble than that of the claimed invention. For example, the recess and protruding portion of the claimed invention allow an easy and simple "snap-like" fit mating, which is elastically engaged. The configuration of the claimed invention also uses less material, which reduces costs. Additionally, the mating of the claimed invention is very secure, used in combination with the remaining features of the claimed invention. In contrast, the configuration of SUZUKI includes more material and would thus be more costly to manufacture. Also, this configuration clearly shows that both of the rings 131a and 131b have smooth surfaces which cannot be equated with

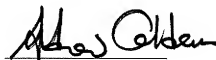
nor is it similar to that of the claimed protruding and recess mating portions of the claimed invention. Furthermore, unlike the invention, member 131b in SUZUKI is just pressed against member 131a by a spring 29b that is disposed between the member 131b and a rod 20. As such, the spring 29b is required to have greater spring constant in order to provide the required pressing together of the members 131a and 131b in addition to urging the rod 20 for the retracted position. As a result of the greater spring constant, a greater force is required to move the rod when the brake pedal is initially pressed down. This means, of course, that the driver will feel that the initial braking is undesirably slower than it should be.

Applicant also incorporates herein the arguments made on pages 14-19 of the Rule 1.116 Amendment.

CONCLUSION

Reconsideration of the Final Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,
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July 31, 2006
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